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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,928	07/31/2003	Clifford Teoh	01-170 (US02)	9672
41696 7590 05/07/2007 VISTA IP LAW GROUP LLP 12930 Saratoga Avenue Suite D-2 Saratoga, CA 95070			EXAMINER NGUYEN, VI X	
			ART UNIT 3734	PAPER NUMBER
			MAIL DATE 05/07/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/631,928

**Applicant(s)**

TEOH ET AL.

**Examiner**

Victor X. Nguyen

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/22/03; 8/23/06</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) received on 12/22/2003 and 8/23/2006, is acknowledged. The submission is in compliance with the provision of 37 CFR 1.97.

Accordingly, the information disclosure statement is being considered by the examiner.

### *Specification*

2. The disclosure is objected to because of the following informalities: In claims 2 and 8, the disclosure does not describe “wherein the structure is comprised of a biodegradable and **biocompatible material**”. In claim 8, the disclosure does not describe “wherein the liner portion comprises a biodegradable and **biocompatible material**”. Furthermore, only on page 25 of applicant’s specification, lines 15-22 does mention “all of the embodiments discussed herein can optionally have biodegradable material such as PGA or PLA”. However, it does not disclose that the structure is comprised of a biodegradable and **biocompatible material**.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites that a distal portion is comprised of a liner supported by the struts; However, claim 7 depends on the claim 6 which includes a disclaimer a distal portion is formed

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of the struts, **free of any covering**. Therefore, claim 7 is contradictory to claim 6 from which it depends, and accordingly, is unclear.

Claim 11 recites the limitation "wherein the shape memory polymer". There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,3-7 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Chin et al. (5,928,260).

Chin et al disclose in figure. 14 F, a system for treating an aneurysm in a vessel, including: a structure 110 has a proximal portion (not labeled, to the left side of element 110 where occurs multiple perforations), a distal portion (not labeled, to the right side of element 110 where occurs plurality of apertures or gaps) which is able to permeate embolics introduced therein through the distal portion. As to claims 3-4, Chin et al disclose in fig. 14f, the distal portion) has perforation sized to permeate embolics (see col.. 9, lines 29-30), and where the proximal portion has perforation sized to permeate blood but to inhibit permeation of embolics

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(see col. 9, lines 27-29). As to claims 5-7, Chin discloses that the proximal portion comprises a liner portion (see fig. 14f) supported by expandable struts 112, where the distal portion is formed of the struts which is free of any covering, and where the distal portion comprised of a liner 170 supported by the struts 78. As to claims 9-10, Chin discloses that the liner portion comprises a shape memory polymer material (where the liner portion is made of weaved or braided mesh which has some form of a shaped memory polymer material such as polyurethane or nitinol, see col. 8, lines 55-62 and col. 11, lines 15-16), and the shape memory polymer is actuatable between the first low profile delivery configuration where it confines the struts to a low profile configuration (see fig. 14e) and a relaxed, expanded configuration (see fig. 14f).

Claims 1,2-4, 7-9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Greenhalgh. (6,346,117).

Greenhalgh discloses in figure. 7, a system for treating an aneurysm in a vessel, including: a structure 42 has a proximal portion (not labeled, the proximal portion occurs below line 54), a distal portion (not labeled, occurs above line 54) which is able to permeate embolics introduced therein through the distal portion. As to claims 2-4 and 8, Greenhalgh discloses the structure or the liner is comprised of a biodegradable (see col. 3, lines 30-34, furthermore, the specification of the present application lists PGA or PLA as one of biodegradable material) and biocompatible material (see col. 3, lines 34-35), where the distal portion has perforations sized to permeate embolics, and where the proximal portion has perforation sized to permeate blood (see col. 9, lines 22—23) but to inhibit permeation of embolics. As to claims 7, 9 and 11 Greenhalgh discloses that the distal portion is comprised of a liner 42 supported by the struts (see fig. 7), and

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where the liner portion comprises a shape memory polymer material (see col. 4, lines 7-15), and the shape memory polymer is actuatable between the first low profile delivery configuration where it confines the struts to a low profile configuration (see fig.5) and a relaxed, expanded configuration (see fig.6).

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No.5,527,337 to Stack

U.S. Pat. No. 5,944,730 to Nobles

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victor X Nguyen  
Examiner  
Art Unit 3734



VN  
4/19/2007